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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,831	08/12/2005	Jean-Marie Gatto	CYBS5819P-PCT/US	2701

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EXAMINER

CHERIYAN JR, THOMAS K

ART UNIT

PAPER NUMBER

3714

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DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,831	Applicant(s) GATTO ET AL.	
	Examiner THOMAS K. CHERIYAN JR	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-142 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/5/2005; 5/23/2005; 11/7/2005; 5/24/2005;</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>1/15/2007; 5/15/2007; 8/3/2007; 1/24/2008</u> | |

DETAILED ACTION

Objections

Claims 1-142 contains the trademark/trade name Microsoft Windows, Software Restriction Policy, System File Protection capability, Driver Signing Capability, Microsoft Driver Signing policy, etc. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe software and software protocols and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-142 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 1-46, 80-100, 135-142, describe a method of operating a gaming machine comprising the basic steps of:

- running the windows operating system on the gaming machine,
downloading at least one software module into the gaming machine.
- checking a code signature of at least one downloaded software module
using a trusted verification driver; and
- authorizing execution of the downloaded software module only if the
downloaded software module is successfully verified by the trusted
verification driver.

Claims 1-46, 80-100, 135-142, does not involve in any way an inventive step because the claims define features inherently built into a Windows operating system and activation of its security features according to need, which are normal design steps and require no inventive activity.

Claims 47-79, 101-133, again involves a similar process as stated in claims 1-46, except however the limitations are broad and do not specify any particular operating system or protocol made by Microsoft. However, knowing that claims 1-46 are already common knowledge to one skilled in the art of security, you can apply the teachings of 1-46 to claims 47-79 and therefore, the claim limitations as taught by 47-79 show that there is no inventive activity.

Claim Rejections - 35 USC § 102 & 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46, 80-100, 135-142 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over England et al (**US 6330670 B1**).

Regarding independent claims 1, 47, 81, 101, and 135, England discloses a method for a gaming terminal (also simply known as a computing device) to authorize execution of a downloaded software (**England, Abstract**), comprising the steps of:

running in the gaming machine a version of Microsoft Windows operating system having Software Restriction Policy capability (**England, Abstract, and Column 10, Lines 14-25 teaches the use of a “license” which tells the software what kind of restrictions is placed on the content that needs to be run in the software.**)

setting the Software Restriction Policy to authorize execution of software code-signed with a certificate from a designated trusted party (**England, Abstract, and Column 10, Lines 14-25 teaches the use of a “license” which tells the software what kind of restrictions is placed on the content that needs to be run in the software.**)

The remaining dependent claims are simply just steps that a user can define in a Windows Operating System as far as setting restrictions goes on content that needs to be run by a software program. These settings are already available to the user since it is built into the Windows Operating System and is therefore obvious that a user can set up a computer system to the settings as claimed in this application. The settings or configurations as stated by these claims is a design choice and is therefore obvious. There is no novelty or inventive step in any of the stated claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas K. Cheriyan whose telephone number is 571-270-3225. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/

Supervisory Patent Examiner, Art Unit 3714